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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/493,545	01/28/2000	Renwen Zhang	GI 5340A	2389

25291 7590 07/31/2003

WYETH  
PATENT LAW GROUP  
FIVE GIRALDA FARMS  
MADISON, NJ 07940

EXAMINER

ROBINSON, HOPE A

ART UNIT PAPER NUMBER

1653

DATE MAILED: 07/31/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application N .

09/493,545

Applicant(s)

ZHANG ET AL.

Examiner

Hope A. Robinson

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 17 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☒ Applicant's reply has overcome the following rejection(s): Rejection under 35 U.S.C. 112, second paragraph.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1,3,6-8,10,13,14,16,17 and 19-21.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_.

Continuation of 5. does NOT place the application in condition for allowance because: the rejection under 35 U.S.C. 103(a) remains, see the attached sheet.

**ADVISORY ACTION**

1. Applicant's response to the Final Office Action mailed January 23, 2003 in Paper No. 23 on July 17, 2003 is acknowledged.

2. Applicant's arguments filed July 17, 2003 have been fully considered but are not persuasive.

The rejection under 35 U.S.C. 112, first second paragraph has been withdrawn.

The rejection under 35 U.S.C. 103(a) has been maintained.

3. Claims 7 and 14 have been amended. Claims 1, 3, 6-8, 10, 13-14, 16-17 and 19-21 are pending and under examination. It is noted that applicant's response omits claim 3 from the pending claims. If applicant intends to cancel this claim, it is suggested that the amendment instructs the PTO to cancel claim 3.

4. Claims 1, 3, 6-8, 10, 13-14, 16-17 and 19-21 are rejected under 35 U.S.C. 103(a) as being obvious for the reasons stated in Paper No. 21. Applicant's response filed July 17, 2003 contends that the combination of the teachings of Hattersley and Pachence represents hindsight. However, Hattersley describes cartilage repair by administering BMP (osteogenic factor) which is known in the art to stimulate growth of bone or tissue and Pachence teach the osteochondral grafts to repair articular cartilage, and it is well known in the art the combination of grafts with BMP because of the benefits of using BMP to stimulate growth. Therefore, one of skill in the art would be motivated to combine the teachings of the references with a high expectation of success as Hattersley teaches that BMP regulates bone and other tissue repair processes.

Applicant also contends that Hattersley uses PTHrP. Although Hattersley teaches the use of

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
PTHrP, the present claim language is open with the use of "comprising" thus other ingredients in the method is permissible. Therefore, applicant's arguments are not persuasive and the rejection of record remains.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hope Robinson whose telephone number is (703) 308-6231. The examiner can normally be reached on Monday-Friday from 9.00 am to 5.30 pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S.F. Low, Ph.D., can be reached at (703) 308-2923.

Any inquiries of a general nature relating to this application should be directed to the Group Receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted by facsimile transmission. The official fax phone number for Technology Center 1600 is (703) 308-4242. Please affix the examiner's name on a cover sheet attached to your communication should you choose to fax your response. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989).

Hope Robinson, MS   
Patent Examiner

  
CHRISTOPHER S. F. LOW  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600